



MAY 11 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
1300 I Street, NW
Washington, D.C. 20005-3315

In re Application of
NAKAJIMA, Kei *et al*
U.S. Application No.: 09/554,065
PCT No.: PCT/JP98/05057
Int. Filing Date: 10 November 1998
Priority Date: 10 November 1997
Attorney Docket No.: 05905.0108
For: CHARACTER COMMUNICATION
DEVICE

DECISION ON
PETITION UNDER 37 CFR
1.47(a)

This is a decision on applicants' "Petition Under 37 C.F.R. §1.47(a)" filed 13 December 2000.

BACKGROUND

On 13 June 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath/declaration in compliance with 37 CFR 1.497(a) and (b), and a surcharge fee for providing the declaration later than thirty months from the priority date as required by 37 CFR 1.492(e) must be provided. Applicants were given one month to respond. Extensions of time were available under 37 CFR 1.136(a).

On 13 December 2000, applicants filed the instant petition which was accompanied by, *inter alia*, a five-month extension request and \$1,890.00 fee; the \$130.00 surcharge fee; a declaration signed by three of the four co-inventors; the \$130.00 petition fee; and a declaration of Mr. Kouji Tsuchiya ("Tsuchiya Decl.")

On 06 February 2001, applicants submitted via facsimile a copy of the documents filed 13 December 2000 and a stamped postcard receipt for those documents.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor refuses to execute the application or cannot be found or reached after diligent effort; (3) a statement of the last known address of the missing joint inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor.

The required petition fee of \$130.00 as set forth in 37 CFR 1.17(i) has been submitted. The last known address of the omitted inventor, Mr. Kei Nakajima, is listed as 19-20, Suite 511, Chuo-Rinkan 3-chome, Yamatoshi, Kanagwa, Japan. Thus, items (1) and (3) of 37 CFR 1.47(a) are satisfied.

Regarding item (2), applicants included a declaration signed by Mr. Kouji Tsuchiya of the Intellectual Property Department of Sega Corporation ("Sega"), who states that he has "first hand knowledge" of the circumstances recited therein. Tsuchiya Decl. ¶ 1. Mr. Tsuchiya claims that upon learning that Mr. Nakajima no longer worked at Sega, he retrieved Mr. Nakajima's address and telephone number from the Personnel Division and "[b]efore sending the application papers (specification, drawings and declaration)," attempted to call him, but "the number was not already used." *Id.* at ¶ 6. Then, Mr. Tsuchiya claims that he "sent a letter by mail to ask for executing the declaration to each of the above addresses on October 18, 2000," but that "the letters were returned to me on October 23, 2000." *Id.* at ¶¶ 7-8. Mr. Tsuchiya elaborated further stating that on the returned envelopes, "the post office indicated that Mr. Nakajima was not found in the address and that his new address was not available to the post office." *Id.* at ¶ 9. Mr. Tsuchiya said that he "asked the Development Division for any information to reach Mr. Nakajima," but no one had any further information concerning how to contact the missing co-inventor. *Id.* at ¶¶ 10-11.

Applicants' burden in proving that an inventor cannot be located is explained in section 409.03(d) of the MPEP which states, in part:

Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, an affidavit or declaration of the facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. **Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration.** It is important that the affidavit or declaration contain statements of fact as opposed to conclusions. (Emphasis added).

The evidence provided is not sufficient to satisfy the requirements of item (2) of 37 CFR 1.47(a). Specifically, documentary evidence discussed in the declaration of Mr. Tsuchiya was not provided. Mr. Tsuchiya discusses sending mail to Mr. Nakajima and having it returned annotated by the post office, but applicants have not provided copies

of such documentary evidence as required above. Applicants must submit any copies of relevant documentary evidence to confirm that a diligent attempt was made to contact Mr. Nakajima. It is also noted that if the evidence is not in English, it must be accompanied by a proper English translation.

Hence, item (2) is not yet satisfied.

Concerning item (4), applicants submitted a declaration signed by three of the five listed inventors, Takao Miyoshi, Yuji Naka, and Shiro Maekawa with the instant petition. The three inventors' names, residences, post office addresses and citizenship are typed on the declaration. In addition, the name, residence, post office address and citizenship of the nonsigning inventor, Mr. Nakajima was listed and left blank as required. However, the name of inventor Katsumi Yabuno was not listed on the declaration. Therefore, the declaration is not acceptable.

Thus, item (4) is also not satisfied.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



Leonard Smith
PCT Legal Examiner
PCT Legal Office



James Thomson
PCT Legal Attorney
PCT Legal Office

Tel.: (703) 308-6457